UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,930	11/14/2003	Madhusudhan Rangarajan	DC-05572	4819

33438 7590 03/22/2006

HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN, TX 78720

EXAMINER	
BAE, JI H	

ART UNIT	PAPER NUMBER
2115	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,930	RANGARAJAN ET AL.	
	Examiner	Art Unit	
	Ji H. Bae	2115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2-17-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-8 and 16-20, the claims recite various components that are "operable" to carry out certain functions. Applicant's language does not clearly define the scope of the claims. Any prior art reference may be considered operable to carry out a given function so long as it does not explicitly disclose that such functionality is prohibited.

Claim 3 recites the limitation "the information handling system BIOS" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. There is no prior recitation of an information handling system BIOS in the claim or its parent.

Claims 5 and 6 each recite the limitation "the boot device" in line 1 of each claim. Claim 4, the parent claim of claims 5 and 6, recites a plurality of "boot devices" [line 2]. Since there are a plurality of boot devices recited in claim 4, it is unclear which boot device comprises "the boot device" of claims 5 and 6.

Claim 7 recites the limitation "the Option ROM execution controller" in lines 1 and 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. There is no prior recitation of an Option ROM execution controller in the claims or its parent.

Claims 19 and 20 variously recite a "hard disc drive" and a "hard disc driver". It is unclear whether applicant intends for these to be two separate limitations, or references to the same limitation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Regarding claims 1-8 and 16-20, the claims recite various components that are "operable" to carry out certain functions. The language employed in the claim communicates potential functionality as opposed to actual functionality, e.g. the claim recites that the Option ROM selector module is "operable" to identify one or more Option ROMs, but does recite that it actually does so.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kroening, U.S. Patent Application Publication No. 2002/0108033 A1, in view of Anderson, U.S. Patent No. 5,974,546.

Regarding claim 1, Kroening teaches a system for managing manufacture of an information handling system, the system comprising a deployment module operable to determine boot commands during manufacture of an information handling system [Fig. 1,

paragraph 16]. Kroening does not teach an Option ROM selector module or an Option ROM boot execution controller.

Anderson teaches an Option ROM selector module [Fig. 3, nonvolatile memory 23, col. 4, lines 9-13] and an Option ROM boot execution controller [self-correction software program 50, col. 4, lines 58-67, col. 8, lines 7-18].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Kroening and Anderson by adding the Option ROM selector module and Option ROM boot execution controller of Anderson to the system of Kroening. Kroening teaches a method of manufacturing a build-to-order computer that requires a number of reboots before the completion of manufacture. Anderson teaches a method of determining a cause of a failed boot sequence. It would have been obvious to one of ordinary skill in the art that failures during the reboot sequences of Kroening would cause a disruption of the manufacturing process and a lower quality product. The addition of Anderson's teachings would improve the system of Kroening by allowing Kroening to determine the cause of such failures and eliminate them.

Regarding claim 2, it would have been obvious to one of ordinary skill in the art to disable all Option ROMs (e.g. if all Option ROMs had failed).

Regarding claims 4-6, the limitations recited are obvious in view of design choice. It would have been obvious to one of ordinary skill in the art that teachings of Kroening and Anderson could have been applied to any device in the system that uses Option ROMs.

Regarding claim 9, Kroening and Lee teaches the system of claims 1, 2, and 4-6. Kroening and Lee also teach the method implemented by the system.

Regarding claims 11 and 13-15, , the limitations recited are obvious in view of design choice. It would have been obvious to one of ordinary skill in the art that teachings of Kroening and Anderson could have been applied to any device in the system that uses Option ROMs.

Regarding claim 12, Kroening teaches that the manufacturing function comprises deploying software to the information handling system [paragraph 16].

Regarding claim 16, the combination of Kroening and Anderson teaches:

plural processing components operable to process information, the processing components assembled to accept applications from a network location, the applications deployed with plural boots of the information handling system [Kroening], selected of the processing components storing Option ROM code for execution at boot of the information handling system [Anderson]; and

an Option ROM boot execution controller interfaced with the processing components and operable to disable execution of selected Option ROM code in one or more application deployment boots [Anderson].

Regarding claims 18-20, the limitations recited are obvious in view of design choice. It would have been obvious to one of ordinary skill in the art that teachings of Kroening and Anderson could have been applied to any device in the system that uses Option ROMs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Mahmoud, U.S. Patent No. 6,061,745;

Wu et al., U.S. Patent No. 6,513,114 B1;

Smith et al., U.S. Patent No. 6,795,914 B2;

Merkin, U.S. Patent No. 5,696,968;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ji H. Bae
Patent Examiner
Art Unit 2115
ji.bae@uspto.gov
571-272-7181

THOMAS LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100